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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/901,764	07/10/2001	Clifton A. Alfemess	1759-12	8600

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EXAMINER

FOREMAN, JONATHAN M

ART UNIT

PAPER NUMBER

3736

DATE MAILED: 03/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

N.K.

# Office Action Summary

Application No.

09/901,764

Applicant(s)

ALFERNES ET AL.

Examiner

Jonathan ML Foreman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 - 16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 - 16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

*Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1 – 11, 13 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Fawzi et al.

In reference to claim 1 and 14, Fawzi et al. discloses a constriction device (100) (Figure 1) that constricts body tissue comprising: an elongated sleeve with opposed open ends formed of expandable material (Col. 5, lines 57 – 60), when in an expanded condition receives body tissue, then when released from the expanded condition, constricts body tissue. The sleeve of the device disclosed by Fawzi et al., has a portion that is visible under X ray fluoroscopy (Col. 5, lines 60 – 66).

In reference to claims 2 – 11 and 13, the sleeve disclosed by Fawzi et al. includes an inner surface, an outer surface, and two opposed opened ends. By introducing the radio-opaque material into the woven braids (Col. 5, lines 60 – 64), the coating of X ray material will be embedded in the side wall, distributed throughout the sleeve on the outer as well as inner surfaces, the longitudinal dimension of the sleeve and adjacent to one of the opposed openings. Fawzi et al. also discloses the use of a plurality of strips in addition to introducing the radio-opaque material into the braids (Col. 5, lines 64 – 66).

*Double Patenting*

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible

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harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1 and 14 are rejected under the judicially created doctrine of double patenting over claims 1 and 3 of U. S. Patent No. 6,491,706 to Alferness et al. since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: a constriction device that constricts body tissue comprising: an elongated sleeve with opposed open ends formed of expandable material, when in an expanded condition receives body tissue, then when released from the expanded condition, constricts body tissue and a portion of the sleeve being visible under X ray fluoroscopy.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

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5. Claims 2 – 13, 15 and 16 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 - 21 of U.S. Patent No. 6,491,706 to Alferness et al. Although the conflicting claims are not identical, they are not patentably distinct from each other because the specification of U.S. Patent No. 6,491,706 to Alferness et al. discloses that the fixation elements are preferably formed of an X ray opaque material such as gold or stainless steel (Col. 7, lines 16 – 17). The MPEP refers two exceptions to the general prohibition of using the disclosure of a potentially conflicting patent or application in an Obviousness-type double patenting analysis. The two exceptions are: The disclosure can be used as a dictionary for claim terminology; and those portions of the specification which provide support for the patent claims may also be examined and considered when addressing the issue of whether a claim in the application defines an obvious variation of an invention claimed in the patent” (MPEP § 804).

### *Response to Arguments*

6. Applicant's arguments filed 1/16/03 have been fully considered. The examiner has withdrawn the 35 USC 103(a) rejection to Alferness et al. in light of the applicant's arguments. Alferness et al. does not teach or fairly suggest a constriction device that constricts body tissue comprising: an elongated sleeve with opposed open ends formed of expandable material, when in an expanded condition receives body tissue, then when released from the expanded condition, constricts body tissue and a portion of the sleeve being visible under X ray fluoroscopy.

7. In response to applicant's argument that the Fawzi et al. reference fails to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., constriction of excised vs. intact tissue; non-suppression of leaks from intact body tissue) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification,

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limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

### *Conclusion*


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan ML Foreman whose telephone number is (703)-305-5390. The examiner can normally be reached on Monday - Friday 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max F Hindenburg can be reached on (703)308-3130. The fax phone numbers for the organization where this application or proceeding is assigned are (703)-308-0758 for regular communications and (703)-308-0758 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-0858.



JMLF  
March 19, 2003

  
**MAX F. HINDENBURG**  
**SUPERVISORY PATENT EXAMINER**  
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